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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/609,221	06/27/2003	Peter R. Van Tyle	MAEE 2 00049	7552

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EXAMINER

OSELE, MARK A

ART UNIT	PAPER NUMBER
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1734

DATE MAILED: 09/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

### Application No.

10/609,221

### Applicant(s)

VAN TYLE ET AL.

### Examiner

Mark A Osele

### Art Unit

1734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-60 is/are pending in the application.
- 4a) Of the above claim(s) 49-59 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 13-16, 19, 26-30, 42-48 and 60 is/are rejected.
- 7) ☒ Claim(s) 6-12, 17, 18, 20-25 and 31-41 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 09222003, 02232004.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

**DETAILED ACTION**

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C.

121:

- I. Claims 1-48 and 60, drawn to a tape dispenser with a radially extending dispensing arm, classified in class 156, subclass 577.
- II. Claims 49-59, drawn to a tape dispenser with a manually operable brake, classified in class 156, subclass 577.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention II has separate utility such as in a holder for a roll of wire. See MPEP § 806.05(d).

2. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

3. During a telephone conversation with Kent Daniels on September 16, 2004 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-48 and 60. Affirmation of this election must be made by applicant in replying to this Office action. Claims 49-59 are withdrawn from

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further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-3, 5, 13-16, 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Regan. Regan shows a tape dispenser comprising an annular support, for a roll of tape and a radially extending arm having a top, 60, and bottom, 90, said bottom including a tape guide with laterally spaced opposite sides, 91, 93, and a central portion of ribs, 116, 126, between and below said sides.

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Regarding claims 3 and 15-16 Regan further shows a tape applicator, 80, forward of the outer end with a serrated cutting edge, 78.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1, 4, and 26-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martin in view of Samuelson. Martin shows a tape dispenser with a planar wall, 15, a tape roll support, an arcuate wall, 14, radially spaced from the tape roll and including a first arm portion, 17, a third arm portion, 27, transverse to the first arm portion, and a tape guide, 25, below and transverse to the first arm portion. Martin fails to show a third arm portion parallel to the first arm portion.

Samuelson shows a tape dispenser with two parallel arm portions, 28, and a tape guide, 18, therebetween. It would have been obvious to one of ordinary skill in the art at the time the invention was made to add a third arm portion to the tape dispenser of Martin because Samuelson shows this type of dispenser is known and a third arm portion would add stability to the dispenser as well as providing protection to the tape.

Regarding claims 4 and 27, Samuelson shows tape retaining tabs, 34. It would have been obvious to one of ordinary skill in the art at the time the invention was made to add the tape retaining tabs of Samuelson in to the apparatus of Martin because Samuelson teaches that tabs help maintain the cut end of the tape adjacent the guide surface and out of contact of the surface of the roll when not in use (column 2, lines 48-53).

Regarding claims 28-29, Martin further shows a tape applicator, 23, and a serrated cutting edge, 26.

9. Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Martin in view of Samuelson as applied to claim 26 above, and further in view of Dretzka et al. The references as combined fail to show ledges. Dretzka et al. shows ledges, 40, extending from parallel arm walls. It would have been obvious to one of ordinary skill in the art at the time the invention was made to add the ledges of Dretzka et al. in to the apparatus of the references as combined because Dretzka et al. teaches that these ledges are useful for attaching sales promotion materials thereto (column 6, lines 29-46).

10. Claims 42-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Regan in view of Lin. Regan shows the claimed limitations except for the brake. Lin show a tape dispenser with a manually operable brake of compressible plates 33A and 33B pressing a portion of a wall against the hub. It would have been obvious to one of ordinary skill in the art at the time the

invention was made to add the known brake of Lin into the apparatus of Regan because braking of the roll prevents free wheeling of the tape (column 3, lines 20-43).

11. Claims 45-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martin in view of Samuelson as applied to claim 26 above, and further in view of Thompson et al. The references as combined fail to show a brake for the tape roll. Thompson et al. shows a tape dispenser wherein the arcuate wall, 56 is movable toward the tape roll to provide a braking function. It would have been obvious to one of ordinary skill in the art at the time the invention was made to add the brake of Thompson et al. into the apparatus of the references as combined to completely stop the dispensing of the tape during tape cutting (column 5, lines 3-18).

12. Claims 45, 47, and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martin in view of Samuelson as applied to claim 26 above, and further in view of Lin. The references as combined shows the claimed limitations except for the brake. Lin show a tape dispenser with a manually operable brake of compressible plates 33A and 33B pressing a portion of a wall against the hub. It would have been obvious to one of ordinary skill in the art at the time the invention was made to add the known brake of Lin into the apparatus of the references as combined because braking of the roll prevents free wheeling of the tape (column 3, lines 20-43).

13. Claim 60 is rejected under 35 U.S.C. 103(a) as being unpatentable over Regan in view of Niermann. As shown in paragraph 6 above Regan shows the claimed limitations except for the arched tape guide. Niermann shows a tape dispenser with an arched tape guide, 76, 78. It would have been obvious to one of ordinary skill in the art at the time the invention was made to arch the tape guide of Regan because Niermann teaches that this arching provides support to the tape (column 6, lines 50-60).

***Allowable Subject Matter***

14. Claims 6-12, 17-18, 20-25, and 31-41 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

15. The following is a statement of reasons for the indication of allowable subject matter: None of the prior art suggest the instantly claimed limitations such as central ribs in the tape guide or converging sides of the tape arm. Carlson et al. shows ribs on the bottom of the tape guide but gives no motivation for their use or for incorporating them into other tape dispensers.

***Information Disclosure Statement***

16. The information disclosure statement filed February 23, 2004 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and



foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. The Patent Abstracts of Japan have not been received.

### ***Conclusion***

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Mathna et al., Shah, and Thompson, Jr. each show tape dispensers with braking means. Huang shows a tape dispenser similar to the instant invention.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark A Osele whose telephone number is 571-272-1235. The examiner can normally be reached on Mon-Fri 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Fiorilla can be reached on 571-272-1187. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Mark A. Osele', is positioned above the printed name and title.

**MARK A. OSELE**  
**PRIMARY EXAMINER**

September 19, 2004